

**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** SATOSHI YAMATO,  
SATOSHI NISHIUMI,  
TOSHIAKI SUZUKI,  
TOSHIYUKI NAKAMURA  
and MAKOTO KIMIZUKA

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Appeal No. 1997-2054  
Application No. 08/332,555

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HEARD: FEBRUARY 23, 2000

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Before HAIRSTON, FLEMING, and DIXON, **Administrative Patent Judges**

FLEMING, **Administrative Patent Judge.**

**DECISION ON APPEAL**

This is a decision on appeal from the final rejection of claims 1 through 27, 29 and 30, all of the claims presently

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pending in this application. Claim 28 has been canceled.

The invention relates to a video game system designed primarily for users who are unfamiliar with computer program or video game creating methodology. Such users may conveniently create a unique video game through an icon driven, interactive computer system that permits a video game to be executed, stopped, edited and resumed from the point where the editing began with the editorial changes persisting throughout the remainder of game play.

Independent claim 1 is reproduced as follows:

1. A method of interactively editing a videographics program being executed in an interactive computing system having a first processor that is operable to execute a videographics program for generating a sequence of videographics display frames for display on a display device, an input device and a second processor, coupled to said input device, that controls videographics program editing operations in response to user inputs via said input device, comprising the steps of:

initiating the execution of said videographics program to display a sequence of display frames on said display device;

stopping the execution of the videographics program at a desired display frame to be edited in response to a user input via said input device;

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transferring videographics program related data from said  
first processor to said second processor; and

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generating an editing related display by said second processor in part in response to said videographics program related data received from said first processor.

The reference relied on by the Examiner is as follows:

San et al. (San) 5,388,841 Feb. 14,  
1995  
(filed Jan. 30,  
1992)

Claims 1 through 27, 29 and 30 stand rejected under 35 U.S.C. § 102 as being anticipated by San.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the brief and answer for details thereof.

## OPINION

After a careful review of the evidence before us, we do not agree with the Examiner that claims 1 through 27, 29 and 30 are anticipated by the applied reference.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. ***See In re King***, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and ***Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.***, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). "Anticipation

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is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention." **RCA Corp. v. Applied Digital Data Systems, Inc.**, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); **cert. dismissed**, 468 U.S. 1228 (1984); **citing Kalman v. Kimberly-Clark Corp.**, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), **cert. denied**, 465 U.S. 1026 (1984). Furthermore, "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by person of ordinary skill.'" **In re Robertson**, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) February 25, 1999) **citing Continental Can Co v. Monsanto Co.**, 948 F.3d 1264, 1268, 20 USPQ2d 1756, 1749 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result for a given set of circumstances is not sufficient." **Id. citing Continental Can Co. v. Monsanto Co.**, 948 F.3d 1264, 1269, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

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On pages 6 and 7 of the brief, Appellants argue that San does not disclose or suggest any method or apparatus for interactively editing a video program as set forth in Appellants' claims. On pages 8 and 9, Appellants argue that San fails to teach a method of using a second processor that controls the video program editing operation in response to user input through the input device as required by the method claims 1 through 23. Appellants further argue on pages 9 through 11 that San does not teach stopping the execution of the program at a desired display frame to be edited as required by the independent method claims 1 and 10. On pages 14 through 16 of the brief, Appellants argue that San fails to disclose a second processor that controls video program editing operations as required by the apparatus claims, claims 24 through 27, 29 and 30.

Upon our review of San, we fail to find that San teaches in any way a method or apparatus for editing a video program as claimed by Appellants. San teaches the use of a second processor to be used as a graphical coprocessor. We find that San fails to contemplate in any way the problem of interactively editing a videographic program being executed in

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an interactive computing system having a first processor operation to execute a video program and a second processor coupled thereto that can control the video program editing operation in response to user input. In particular, we find that San fails to contemplate stopping the execution of the video program at a desired display frame to be

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edited in response to the user input. Therefore, we will not sustain the Examiner's rejection of Appellants' claims because the Examiner has failed to show that San teaches every element of these claims.

In view of the foregoing, the decision of the Examiner rejecting claims 1 through 27, 29 and 30 is reversed.

**REVERSED**

KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
MICHAEL R. FLEMING	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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	)	
JOSEPH L. DIXON	)	
Administrative Patent Judge	)	

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MRF/dal

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